

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte TETSURO MOTOYAMA and AVERY FONG

Appeal No. 2006-2674
Application No. 09/453,937
Technology Center 2100

Decided: April 9, 2007

Before LANCE LEONARD BARRY, ALLEN R. MACDONALD,
and JEAN R. HOMERE, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-9 and 11-20. The Appellants appeal under 35 U.S.C. § 134. We have jurisdiction under 35 U.S.C. § 134(a).

II. FACTS

The invention at issue on appeal transmits data, which describe a monitored application unit, to a remote party in different formats. Examples of application

units include copying machines, facsimiles, and appliances. Examples of the data transmitted include error conditions and warning conditions. (Appeal Br. at 2.) By supporting multiple formats, the invention increases the likelihood that the receiver will understand the data. (Spec., abs.) A further understanding of the invention can be had by reading the following claim.

18. A computer-implemented method for causing a computer to control a format used for data communication to a remote receiver, comprising:

providing plural communications formats capable of providing data transfer;

selecting a first format of the plural communications formats to transfer data between the remote receiver and at least one of a device, an appliance, an application and an application unit;

selecting a second format of the plural communications formats to transfer data between the remote receiver and the at least one of a device, an appliance, an application and an application unit;

collecting events at the at least one of a device, an appliance, an application and an application unit;

dynamically generating first and second format processors for implementing the first and second formats;

performing a first attempt to transfer the collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the first format processor;

checking for a transmission failure in the first attempt; and

performing a second attempt to transfer the collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the second format processor after the first attempt if there was a transmission failure in the first attempt.

Claims 1-6, 9, 11-13, and 18-20 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,818,603 ("Motoyama") and U.S. Patent No. 5,842,039 ("Hanaway"). Claims 7, 8, and 14-17 stand rejected under § 103(a) as obvious over Motoyama; Hanaway; and U.S. Patent No. 5,911,776 ("Guck").

III. ISSUE

"Rather than reiterate the positions of the examiner or the appellants *in toto*, we focus on the point of contention therebetween." *Ex parte Muresan*, No. 2004-1621, 2005 WL 951659, at *1 (B.P.A.I. 2005). The examiner makes the following admission.

Motoyama does not disclose a sixth computer code device configured to attempt to transfer the collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the first format processor; a seventh computer code device configured to attempt to transfer the collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the second format processor after attempting to transfer the collected events

between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the first format processor, wherein the seventh computer code device is configured to check for a transmission failure before transferring [sic] the collected events using the second format.

(Examiner's Answer at 4.) In attempt to cure the shortcoming of the primary reference, the examiner makes the following assertions regarding the secondary reference.

Hanaway discloses a method to be used with a programmable controller that can communicate with peripheral devices in two protocols. When a message is received, the controller determines if the message is in the controller's currently configured protocol (col. 3, lines 24-26). When the controller tries first protocol then tries the second protocol after the first protocol is finished (col. 6, lines 50-65, Fig. 3). Hanaway further discloses (in col. 3 lines 11-20 and 41-65) in that there is a "determination" or check (as claimed) (e[.]g., see col. 3 (line 54)) to see if the first format failed and thus the message is communicate [sic] in the second format after conducting the check.

(*Id.* at 4-5.) The appellants argue, "the controller 10 does not need to send in a second, different format after having experienced a transmission failure because it is the receiver (not the transmitter) and it will know the proper format from the reception." (Appeal Br. at 4.) Therefore, the issue is whether the examiner has properly established a prima facie case of obviousness.

In addressing the issue, the Board conducts a two-step analysis. First, we construe the independent claims at issue to determine their scope. Second, we determine whether the construed claims would have been obvious.

IV. CLAIM CONSTRUCTION

"Analysis begins with a key legal question — what is the invention claimed?" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "the PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324, 72 USPQ2d 1209, 1211 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000)).

Here, independent claim 18 recites in pertinent part the following limitations:

performing a first attempt to transfer the collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the first format processor;

checking for a transmission failure in the first attempt; and

performing a second attempt to transfer the collected events between the remote receiver and the at least one of a device, an appliance, an application and an application unit using the second format processor after the first attempt if there was a transmission failure in the first attempt.

Independent claim 1 includes similar limitations. Giving the independent claims the broadest, reasonable construction, the limitations require attempting to send data from via a format and, if the attempt fails, resending the data via a different format.

V. OBVIOUSNESS DETERMINATION


"Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious." *Ex Parte Massingill*, No. 2003-0506, 2004 WL 1646421, at *3 (B.P.A.I 2004). "In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, Hanaway's method "is used with a dual-protocol programmable controller that receives messages from programming and monitoring apparatus and provides data thereto via an interface port." (Col. 3, ll. 31-34.) Although an attempt of the programming and monitoring apparatus to send a message to the

programmable controller may fail and require resending the message, (col. 6, ll. 50-61), we cannot find that the message is resent in a different protocol, i.e., a different format. To the contrary, "[w]hen messages are received, the controller determines if the messages are in the controller's currently configured protocol. When the messages are not in the currently configured protocol, the controller automatically reconfigures itself in its other supported protocol for communication in the other protocol." (Col. 3, ll. 34-39.) Because the controller has reconfigured itself for the proper protocol, the apparatus need, not resend the message in a different protocol. Instead, the apparatus can resend the messages in the same protocol. Furthermore, the examiner does not allege, let alone show, that the addition of Guck cures the aforementioned deficiency of Motoyama and Hanaway.

VI. CONCLUSION

Absent a teaching or suggestion of attempting to send data from via a format and, if the first attempt fails, resending the data via a different format, we are unpersuaded of a prima facie case of obviousness. Therefore, we reverse the obviousness rejections of claims 1 and 18 and of claims 2-9, 11-17, 19, and 20, which depend therefrom.


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